

REMARKS

Claims 1-6 have been amended. Upon entry of the above amendments and following remarks claims 1-6 will be pending in the present application.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1-2 and 5-6 have been rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,449,870 to Perez. Applicant notes the proper standard under 35 U.S.C. §102 for finding anticipation is that the prior art must disclose each and every limitation found in the claims, either expressly or inherently. Rockwell International Corp. v. United States, 147 F.3d 1358, 1363 (Fed. Cir. 1998); Electro Med System S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Furthermore, the omission of any claimed element no matter how insubstantial is grounds for traversing a rejection based on Section 102. Connell v. Sears Roebuck & Co., 772 F.2d 1542 (Fed. Cir. 1983).

Applicant asserts that Perez does not, at a minimum, disclose a device having, an electrically isolated thermal-capacitance element configured to moderate air temperature of air exhausted through the nozzle by absorption, retention and re-radiation of thermal energy contained in the air exhausted through the nozzle. In stark contrast, Perez requires an “electric heat generating coil” which is intended to modulate heat. Perez, column 1, line 46; column 2, lines 20-33. By necessity the electric heat generating coil is not electrically isolated since it is connected to an electrical power source. In addition, the temperature sensor 68, which the Examiner refers to as a “thermal-capacitance element”, is required to be electrically coupled to, and therefore not electrically isolated from, an electrical control circuit. Perez, column 6, lines 3-23. As such, a rejection of claims 1-2 and 5-6 under 35 U.S.C. §102 cannot be made.

Claim Rejections Under 35 U.S.C. §103

Claims 3 and 4 have been rejected under 35 U.S.C. §103 as unpatentable over Perez, and Claims 7 and 8 have been rejected under 35 U.S.C. §103 as unpatentable over Perez in view of U.S. Patent No. 6,094,837 to Cantor. Applicant notes that the Examiner has set forth “[t]he factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)”. However, the Applicant does not see where the Examiner has provided a nexus between the “factual inquiries” and the Examiner’s reasoning for rejecting claims 3, 4, 7, and 8 under 35 U.S.C. §103.

Applicant respectfully reminds the Examiner that it is incumbent upon an examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, an examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by an examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Claims 3, 4, 7, and 8 depend either directly or indirectly on amended claim 1. As such, a rejection of claims 3, 4, 7, and 8 is improper since at a minimum Perez does not teach or suggest all the claim limitations. For example, at a minimum Perez does not teach or suggest a device having an electrically isolated thermal-capacitance element configured to moderate air temperature of air exhausted through the nozzle by absorption, retention and re-radiation of thermal energy contained in the air exhausted through the nozzle. As such, a proper rejection of claims 3, 4, 7, and 8 under 35 U.S.C. §103 cannot be made.

Claim 3 Additionally Patentable

Claim 3 is additionally patentable for at least the reason that Perez fails to disclose a pair of said elements in parallel spaced-apart interrelationship.

Applicant respectfully reminds the Examiner that the analysis of whether a claim is patentable over the prior art under 35 U.S.C. §103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, claim 3 must be examined to derive an understanding of the scope and content thereof. Claim 3 clearly includes a pair of said elements in parallel spaced-apart interrelationship. Applicant notes that the Perez disclosure is devoid of a pair of said elements in parallel spaced-apart interrelationship.

Applicant respectfully directs the Examiner's attention to page 4, lines 3-9 of the Applicant's specification which states that "[e]xtending across the aperture 12 is a pair of elements 13" In addition, page 5, lines 1-5 of the specification states that "elements in the form of flat louvers as depicted...suitable for absorbing and relinquishing thermal energy to the flow of air through the nozzle". Thus, the Applicant's specification, at least in the above recited portions, clearly show the benefit derived from having a pair of said elements in parallel spaced-apart interrelationship. Therefore, the limitation regarding a pair of said elements in parallel spaced-apart interrelationship is clearly a structural limitation that

should have been given weight by the Examiner. The Examiner's unsupported, conclusionary, statement regarding obvious design choice is not a substitute for evidence. As the examiner has not pointed to any teaching or suggestion in the prior art that would have suggested having a pair of said elements in parallel spaced-apart interrelationship, the Examiner has failed to establish a prima facie case of obviousness of claim 3. Accordingly, a proper rejection the of claim 3 under 35 U.S.C. §103(a) cannot be made.

Claim 4 Additionally Patentable

In addition, claim 4 is additionally patentable for at least the reason that Perez fails to disclose an electrically isolated thermal-capacitance element wherein the element is made of a material selected from the group consisting of ceramic, metal and glass.

Claim 4 clearly includes an electrically isolated thermal-capacitance element wherein the element is made of a material selected from the group consisting of ceramic, metal and glass. Applicant notes that the Perez disclosure is devoid of an electrically isolated thermal-capacitance element wherein the element is made of a material selected from the group consisting of ceramic, metal and glass.

Applicant respectfully directs the Examiner's attention to page 4, lines 3-9 of the Applicant's specification which states that "[e]xtending across the aperture 12 is a pair of elements 13 which might be made of ceramic, glass, metal... that has a desirable thermal capacitance and can absorb thermal energy from a flow of air, retain the thermal energy and re-radiate or conduct the stored thermal energy back to the air flow" Thus, the Applicant's specification, at least in the above recited portion, clearly shows the benefit derived from having an electrically isolated thermal-capacitance element wherein the element is made of a material selected from the group consisting of ceramic, metal and glass. Therefore, the limitation regarding an electrically isolated thermal-capacitance element wherein the element is made of a material selected from the group consisting of ceramic, metal and glass is clearly a structural limitation that should

have been given weight by the Examiner. The Examiner's unsupported, conclusionary, statement regarding obvious design choice is not a substitute for evidence. As the examiner has not pointed to any teaching or suggestion in the prior art that would have suggested having an electrically isolated thermal-capacitance element wherein the element is made of a material selected from the group consisting of ceramic, metal and glass, the Examiner has failed to establish a prima facie case of obviousness of claim 3. Accordingly, a proper rejection of claim 3 under 35 U.S.C. §103(a) cannot be made.

In summary, the Applicant has addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited.

Respectfully Submitted,

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